

REMARKS

Claims 1-23 are pending in the instant application. Applicants appreciate the allowance of Claim 15. Claims 1, 2, 11, 12 and 14 have been amended, Claims 13, 21 and 22 cancelled and Claims 23-25 are submitted for consideration by the Examiner. Support for the new Claims can be found, for example, on Page 7, Line 7 and Page 10, Lines 15-30 of the instant application. Applicants respectfully request reconsideration and allowance of the instant application.

The rejection of Claims 2-10, 12 and 16-22 under 35 U.S.C. 103(a) as being unpatentable over Chang et al (U.S.P.N. 6,368,438B1) or Nakazato et al. (U.S.P.N. 5,804,608), is respectfully traversed. Applicants reserve the right to challenge Chang as being prior art to the claimed invention.

Neither Chang nor Nakazato disclose an expandable composition comprising SBR and at least one member selected from the group consisting of polybutadiene rubber, ethyl vinyl acetate, ethylene diene monomer and ethylene-acrylic acid polymer. Accordingly, Applicants respectfully submit that the applied references cannot establish a prima facie case of obviousness.

The rejection of Claims 1-10 and 12-22 under 35 U.S.C. 103(a) as obvious over Kozma et al (U.S. Patent Nos. 6,262,137B1 and 6,242,503B1) in view of Chang et al. (U.S.P.N. 6,368,438B1) or Nakazato et al. (U.S.P.N. 5,804,608), is respectfully traversed. Applicants reserve the right to challenge Kozma and Chang as being prior art to the claimed invention.

Kozma fails to disclose an expandable material comprising styrene butadiene rubber. Kozma fails to disclose an automotive sealant that is self-retaining. Further, Kozma fails to disclose automotive sealants. While Kozma does disclose automotive "applications" (Col. 1, Line 28 of Kozma), it is reasonable to conclude that Kozma was referring to automotive cushions; not a sealant application.

Moreover, Kozma fails to disclose a sealant have a defined configuration prior to expanding. Kozma discloses an expandable material in the form of beads, particles and sheets (e.g., ref to Col. 2, Lines 24-29, Col. 8, Lines 55-62 and Col. 12, Lines 14-17 of Kozma).

These deficiencies of Kozma are not remedied by the secondary references Chang et al or Nakazato. A skilled person in this art would lack any motivation to combine Kozma and Chang or Nakazato, and to substitute the base polymer utilized in Kozma for another polymer identified by Chang or Nakazato. The basis for combining these references is the disclosure of certain compounds in the secondary references. Mere disclosure is insufficient to motivate one to combine references and in turn selectively reformulate a desirable combination. Existence of certain compounds, without more, cannot motivate one to combine references and, once combined, to reformulate a composition in a manner not completed.

Assuming arguendo that there was some motivation to combine the applied references, the disclosure of Chang and Nakazato Chang and Nakazato contain the

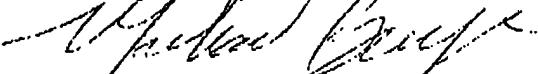
BEST AVAILABLE COPY

deficiencies discussed above. For these reasons, Applicants respectfully submit that Kozina with Chang or Nakazato fail to render the claimed invention obvious and, accordingly, request withdrawal of this rejection.

Applicants believe that the Amendment overcomes the rejections under 35 U.S.C. 112 and 101. Applicants request withdrawal of these rejections.

Applicants believe that the pending claims define patentable subject matter and respectfully request issuance of a Notice of Allowability for the instant application. Should there any other fee due in connection with the instant application, please charge the same to Deposit Account No. 15-0680 (Orscheln Management Co.). Should the Examiner deem that any further action on the part of Applicants would advance prosecution of this application, the Examiner is invited to telephone Applicants' attorney.

Respectfully Submitted,


Michael K. Boyer
Attorney for Applicants
U.S.P.T.O. Reg No 33085
tel: 660 269-4536
fax: 660 269-4530
email: mboyer@orscheln.com

Encl.: Certificate of Facsimile Transmission Dated: July 05, 2002

BEST AVAILABLE COPY

Version With Markings To Show Changes Made

Please amend Claims 1, 2, 11, 12 and 14 as follows:

1(Three Times Amended). An [injection molded unexpanded] expandable composition comprising a combination comprising at least one base polymer comprising at least one maleic anhydride modified copolymer of ethylene, at least one expansion agent, at least one hydrocarbon resin, at least one member selected from the group consisting of polybutadiene rubber, ethyl vinyl acetate, ethylene diene monomer and ethylene-acrylic acid polymer; and at least one curing agent[, wherein the composition comprises a self-retaining automotive sealant and said sealant has a predetermined three dimensional shape and wherein a portion of said sealant retains said sealant at a predetermined location with respect to an automotive member to be sealed].

2(Three Times Amended). A[n injection molded] composition comprising a combination comprising at least one copolymer base polymer comprising styrene butadiene rubber, at least one expansion agent, at least one hydrocarbon resin, at least one member selected from the group consisting of polybutadiene rubber, ethyl vinyl acetate, ethylene diene monomer and ethylene-acrylic acid polymer [and at least one curing agent wherein said composition is substantially free of inorganic compounds].

11(Amended). A[n] self-retaining, injection molded and heat expandable [composition substantially having the configuration illustrated in any one of Figures 1 through 6] sealant comprising a compressible protuberance dimensioned for insertion into a member to be sealed and at least two extensions that extend along at least a portion of an exterior surface of the member to be sealed.

BEST AVAILABLE COPY

12(Three Times Amended). A [u injection molded] heat expandable composition comprising a combination comprising at least one base polymer comprising styrene butadiene rubber, at least one supplemental polymer comprising ethyl vinyl acetate, at least one expansion agent, at least one catalyst and at least one filler [and wherein said composition is self-retaining].

14(Amended). [Use of the composition of Claim 1 as an automotive sealant} A method for sealing comprising:

providing a sealant having a three-dimensional configuration that defines at least one protuberance, at least one opening and at least two extensions,
compression fitting at least a portion of said protuberance into a member to be sealed wherein said at least two extensions extend along an exterior of the member to be sealed; and,

heating under conditions sufficient to expand said sealant thereby providing a seal and at least partially embedding the member to be sealed in said sealant.

Please cancel Claims 13, 21 and 22 without prejudice or disclaimer to the subject matter recited therein.

Please add new Claims 23-25 as follows:

23. The method of Claim 14 wherein said member to be sealed comprises at least one automotive component.

24. The method of Claim 23 wherein said automotive component comprises at least one member selected from the group consisting of an A-pillar, B-pillar or C-pillar.

JUL-05-02 FRI 03:03 PM

FAX NO.

P. 09

25. The method of Claim 23 wherein the sealant comprises the composition of any one of Claims 1, 2 or 12,--

BEST AVAILABLE COPY